

HEWLETT-PACKARD COMPANY
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PATENT APPLICATION
Attorney Docket No: 200309766-1
Application No. 10/817,135

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

Inventors:	Valerie Marty et al.	Examiner:	Roberts Culbert
Application No:	10/817,135	Group Art Unit:	1763
Filing Date:	April 1, 2004	Confirmation No:	1502
Title: A METHOD OF CREATING A MONOLAYER ON A SURFACE			

**COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450**

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

In response to Examiner's Office Communication dated March 22, 2006 Applicants respond as follows:

Examiner has identified two distinct inventions:

- I. Claims 1-29 drawn to a method, classified in class 216, subclass 36; and
- II. Claims 30-54 drawn to a component, classified in class 428, subclass 195.1.

Applicants affirm that the above two groups identified by the Examiner are patentably distinct. However, Applicants believe that the restriction requirement is improper for a couple of reasons and traverse this restriction requirement. First, Applicants note Examiner has not provided any argument that the two groups are independent as required by 35 U.S.C. §121 which states "[i]f two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." *Emphasis added*. Clearly from 35 U.S.C. §121 the Examiner cannot require restriction unless two or more independent and distinct inventions are claimed. Applicants further note if there is a discrepancy between 35 U.S.C., 37 C.F.R., and/or the MPEP then 35 U.S.C. preempts 37 C.F.R. and both 35 U.S.C. and 37 C.F.R. preempt the MPEP. Thus, Applicants argue that although the MPEP may state independent or distinct; both 35 U.S.C. §121 and 37 C.F.R. §1.141

clearly state that the requirement for restriction requires that the inventions be independent and distinct. Therefore, Applicants assert that 35 U.S.C. §121 and 37 C.F.R. §1.141 preempt the MPEP if there indeed is a discrepancy in the MPEP in regards to restriction requirements. In addition, MPEP 806.06 clearly states that two or more inventions are independent, if they are unconnected in design, operation, and effect. Further, MPEP 806.06 also states that the Examiner can only require restriction when Examiner has shown that the two or more inventions are independent, and Examiner has shown that there would be a serious burden on the Examiner if restriction is not required. Therefore, Applicants believe Examiner has not established a prima facie case for restricting the claims of the application based on the lack of a reasoned argument how the groups asserted to be distinct are independent and distinct as required by 35 U.S.C. §121.

Second, Examiner's restriction requirement has not established that an undue burden would be required if the restriction requirement either was not issued or if issued with fewer species. More particularly, MPEP §803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present application, no undue burden has been established, by Examiner, if each of the claims were examined together. In particular Examiner has neither indicated nor has given any arguments as to why prosecution of claims to groups I and II together presents any serious burden as required by MPEP §803.

The present restriction requirement not only improperly shifts the Examiner's burden to the Applicants, but also subjects the Applicants to the added financial burden of prosecuting different claims in an unreasonable number of separate proceedings.

Applicants respectfully request that Examiner reconsider the current restriction and withdrawn this restriction requirement.

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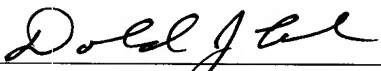
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Thus, Applicants hereby provisionally elect with traverse Group I covering claims 1-29. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional, continuation, and/or continuation-in-part applications that cover the non-elected claims.

The examiner has required restriction between product and process claims. Where Applicants elect claims drawn to the process, and the process claims are subsequently found allowable, withdrawn product claims that depend from or otherwise include all the limitations of the allowable process claims will be rejoined in accordance with the provisions of MPEP §821.04. Product claims that depend from or otherwise include all the limitations of the patentable process will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

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Respectfully submitted,
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Date: 18-Apr-06